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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,628	03/19/2001	Jean-Christophe Henrion	05725.0868-00	7362

22852 7590 10/01/2002

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EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/01/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,628

Applicant(s)

HENRION ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 45-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5. 6) ☐ Other: _____

DETAILED ACTION

Claims 1-50 are pending.

Election/Restrictions

Applicant's election with traverse of Group I, claims 1-44, and election of the compound of example 1 as the species readable thereon is acknowledged. Claims 45-50 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11. The traversal is on the ground(s) that the Office has not shown a serious burden exists to examine the claims of Groups I and II together because applicant asserts that the search for each group should substantially overlap. Applicants further submit they have a statutory right to claim the subject matter they regard as their invention as they choose. This is not found persuasive because, as indicated in the previous Office Action, the Groups I and II are unrelated and subject to separate classifications in the art, which clearly shows that the search within the patent literature for each group is not coextensive. Therefore, a serious burden exists with respect to the search and examination of both groups.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-19, 21-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Cheng et al (J. Med. Chem., 1993, vol. 36, pages 4108-4112). Cheng does not disclose or suggest the elected species of Applicant's Example 1. Therefore, the claims are examined as they read on the examples of Cheng, especially compound 5c (see page 4108). Cheng discloses benzonaphthofurandione derivatives and their biological activity against leukemia cells. Compound 5c is substituted with chloro and hydroxy groups. Aqueous compositions are described, which meet the limitation of cosmetically acceptable (see Material and Methods, page 4111). A range of percentages is presented (see Experimental Section for 5c, and Materials and Methods, page 4111). The intended use of 21-23 and 25-32 is not given patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sartori (US Pat. 2,940,983) in view of Gaydos (US Pat. 3,856,026).

The instant claims are drawn to compositions comprising a compound of formula (I) and methods of making such compositions. The elected species of formula (I) is 5-chloro-dinaphtho-(1,2-b:2',3'-d)furan-7,12-dione (see specification, page 29, Example 1; CA registry number 361145-47-3). Various embodiments of the invention include mascara and other make-up products (see for example claims 27 and 39).

Sartori teaches halogen-substituted dinaphthofurandiones (see entire disclosure). While Sartori does not teach the elected compound, Sartori teaches 8-chloro-dinaphtho-(1,2-b:2',3'-d)furan-7,12-dione and 11-chloro-dinaphtho-(1,2-b:2',3'-d)furan-7,12-dione, which are positional isomers of the elected compound, and therefore render the elected compound obvious (see col. 6, claims 3 and 5). The compounds are useful as dyes and intermediates (see col. 1, lines 10-16). Specifically, the compounds are useful as disperse dyes for polyester fibers (see col. 1, lines 40-45). The dyeings yield bright, strong colors of good sublimation fastness (see col. 1, lines 50-55). The reference lacks the use of the compounds in cosmetic compositions.

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Gaydos teaches the use of flock as a cosmetic product for nails, hair, eyelashes, and other areas of the body (see abstract; and col. 1, lines 1-20). The flock is adhered to body surfaces to enhance the appearance or attractiveness of these areas. The flock as taught by Gaydos includes polyester fibers in various colors (see col. 1, lines 42-56). Therefore, polyester fibers in various colors have art-recognized suitability for the intended purpose of formulating a cosmetic composition for nails, hair, eyelashes, and other areas of the body, as demonstrated by Gaydos. The selection of a known material based on its suitability for its intended use has been determined to be *prima facie* obvious. See *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and MPEP 2144.07.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used polyester fibers dyed with the compounds of Sartori in cosmetic compositions as taught by Gaydos in order to benefit from polyester fibers in various colors with bright, strong colors of good sublimation fastness as taught by Sartori.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.



Michael A. Willis
Examiner
Art Unit 1617

maw
September 26, 2002



SREENI PADMANABHAN
PRIMARY EXAMINER

9/27/02